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In re Application of SHI et al.

Application No.: 09/763,163

PCT No.: PCT/JP00/03874

Int. Filing: 15 June 2000

Priority Date: 24 June 1999

Attorney Docket No.: L9289.01113PCT

For: WIRELESS COMMUNICATION
APPARATUS AND WIRELESS
COMMUNICATION METHOD

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: DECISION ON PETITION
: UNDER 37 CFR 1.47(a)
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This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 29 March 2001.

BACKGROUND

On 29 March 2001, applicants, in response to 20 March 2001 Notification of Missing Requirements, filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Guizeng Shi. The petition included the requisite petition fee, a declaration of Osamu Kato, regarding Mr. Shi's refusal to sign, and a declaration signed by the 37 CFR 1.47(a) applicants, Osamu Kato and Mitsuru Uesugi, on behalf of nonsigning inventor Guizeng Shi.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3) and (4) have been submitted and satisfy the requirements of 37 CFR 1.47(a).

With respect to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

[Emphasis added]

Here, Petitioner submitted a declaration of Osamu Kato, indicating his attempt to secure the signature of Guizeng Shi on a declaration under 37 CFR 1.63 and assignment in the above referenced application on behalf of Matsushita Electric Industrial Co. Mr. Kato states that on 06 February 2001, he sent a declaration and assignment to Mr. Shi for his signature. Mr. Kato states that his correspondence "was returned to sender after a one-week custodial period due to absence of the recipient". This is insufficient evidence to conclude that Mr. Shi refuses to sign

the *application papers*. Furthermore, the fact that the documents were returned after Mr. Shi's one week absence does not indicate a refusal or unavailability to sign. It may be that Mr. Shi was unavailable due to vacation or out of town for that period.

What is required is that Mr. Shi be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for the above identified application. The affidavit as to Facts under 37 CFR 1.47(a)(2) should be signed by the person having first hand knowledge of the inventor's refusal. Where there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. Where there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

Petitioner has not demonstrated: (1) a *bona fide* attempt was made to present a copy of the *application papers* for U.S. application 09/647,630 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address and (2) Mr. Shi's refusal to sign, either in writing or by telephone, these documents.

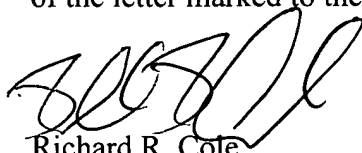
In sum, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

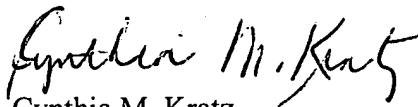
The petition under 37 CFR §1.47(a) is **DISMISSED** without prejudice.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No additional petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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